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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,678	12/08/2003	Thomas P. Warner	WS-0001	5721
7590	03/08/2006		EXAMINER	
John Buckert 36612 Tulane Drive Sterling Heights, MI 48312			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,678

Applicant(s)

WARNER, THOMAS P.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-18, 20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-18, 20 and 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Withdrawal of Final**

In view of a double patenting rejection that should have been applied, and further in view of reconsidered rejections, the Final Rejection of August 10, 2005 is hereby withdrawn and an action on the merits follows.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 12-17, 20, 22-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beier et al (4571681) in view of Murry et al (4156187) and Beier et al (4305126). Beier (681) shows a system for controlling devices shown in the figure, a foot pedal 16, 75, a processor including memory, data routers, summing circuit and a micro processor 61. This processor system is operationally associated with 16 and 75, the association being shown in the sole Figure. The system determines which instrument is selected and generates and transmits over lines a different signal depending on the device that is selected, column 6, lines 12-25. Beier (681) does not show a remote controller. Murry teaches that it is a known alternative to use a foot pedal that is either wired, Fig. 3, or remote, Fig. 2 and column 14, lines 19-46. It would be obvious to one of ordinary skill in the art to modify Beier (681) to include a remote controller as shown by Murry in order to make use of art known alternatives to control medical

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equipment without being restricted by wires. While Beier (681) shows using a general type processor for the overall system, the reference does not show using a microprocessor. Beier (126) teaches using a microprocessor 100 for control and communication between the different modules. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a microprocessor as shown by Beier (126) in order to make use of well known control processors in the art to best control the devices. As to claims 4 and 6, Beier (681) teaches using microprocessors for control circuitry and Beier (126) teaches using a microprocessor. The specific parameters controlled would be obvious to the skilled artisan in the parameters desired. As to claims 12-14, Beier (681) teaches a position sensor in the form of a potentiometer, column 5, lines 17-47. The specific number of different signals used and type of signals is an obvious matter of choice in the specific controls desired to the skilled artisan. Foot pedals are known to have movable members.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beier et al (4571681) in view of Murry et al (4156187) and Beier et al (4305126) as applied to claim 6 above, and further in view of Jones et al (4114275). The above combination does not show using a pneumatic valve switch. Jones teaches that it is known to use pneumatic valve switches for controls. It would be obvious to one of ordinary skill in the art to modify the above combination to include a pneumatic valve as shown by Jones in order to best control the devices in the desired manner.

Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beier et al (4571681) in view of Murry et al (4156187) and Beier et al (4305126) as applied to claims 1 and 22 above, and further in view of Fornoff et al (5931669). The above combination does not show using a video board. Fornoff teaches using a camera and freezing video, column 4, lines 21-37. It would be obvious to one of ordinary skill in the art to modify the above combination to include a using a camera and system that allows for video to be frozen as shown by Fornoff in order to better see the work site. It is well known to the skilled artisan to use a video board and video card to capture stills. Storing images in memory is well known in the art.

Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beier et al (4571681) in view of Murry et al (4156187) and Beier et al (4305126) as applied to claims 1 and 22 above, and further in view of Nash (4171572). Beier (681) also teaches activation and deactivation using threshold value indicators, column 6, lines 54-66, however, the above combination does not show using a timer. Nash teaches using a timer 34. It would be obvious to one of ordinary skill in the art to modify the above combination to include a timer as shown by Nash in order to insure operation of the devices only when desired.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7, 12-18, 20 and 22-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 23-28, 31-35 and 38-43 of copending Application No. 10/464,369 in view of Beier et al (4305126). The claims of the '369 application are directed to a system including a foot pedal that activates first and second devices using first and second RF signals, however, does not claim using a microprocessor. Beier teaches that it is known to use a microprocessor 100 to control a device system. It would be obvious to one of ordinary skill in the art to modify the claims of the '369 application to include a microprocessor control as taught by Beier in order to make use of art known ways to better control parameters in a system of devices.

This is a provisional obviousness-type double patenting rejection.

Claims 8-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 23-28, 31-35 and 38-43 of copending Application No. 10/464,369 in view of Beier et al (4305126) as applied above, and further in view of Jones et al (4114275). The above combination does not show using a pneumatic valve switch. Jones teaches that it is known to use pneumatic valve switches for controls. It would be obvious to one of ordinary skill in the art to modify the above combination

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to include a pneumatic valve as shown by Jones in order to best control the devices in the desired manner.

This is a provisional obviousness-type double patenting rejection.

Claims 29 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 23-28, 31-35 and 38-43 of copending Application No. 10/464,369 in view of Beier et al (4305126) as applied above, and further in view of Nash (4171572). The above combination does not show using a timer. Nash teaches using a timer 34. It would be obvious to one of ordinary skill in the art to modify the above combination to include a timer as shown by Nash in order to insure operation of the devices only when desired.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's arguments filed December 27, 2005 have been fully considered but they are not persuasive.

Applicant argues that there is not motivation to combine Beier (681) with Murry because Beier (681) is directed to supplying variable voltage levels while Murry transmits signals to select different instruments, and therefore, if Murry is combined with Beier (681), the supplying of variable voltage levels would be destroyed. This argument is not agreed with because Murry has been used to show a known alternative way to transmit signals, that is remotely or by wire, and as such, suggests the combination. One of ordinary skill in the art would not have to

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inherently substitute all of the functions of Murry into Beier (681) to achieve the combination, and therefore, the combination would not destroy the Beier (681) reference.

Applicant argues that not every limitation has been met because Beier (681) does not show using a microprocessor to determine the selected instrument or to induce an RF signal, instead, Beier (681) uses an encoder, and the suggestion at column 6, lines 12-20, in Beier (681) to use a computer does not teach the above. Further, Murry does not show using a computer. This argument is not agreed with because Beier (681) does show a processor or processors that function as described above, and therefore, the only difference in the claimed processor is the type of processor used. The newly applied reference to Beier (126) teaches it is known to use a microprocessor. As stated, Beier (681) teaches the functions of determining the selected instrument and inducing a signal. That the signal may be an RF signal is properly shown by Murry. That the processor used to perform these function may be a microprocessor is properly taught by Beier (126).

Applicant argues that Murry does not define what is meant by RF in column 14, lines 31-35, and further is directed to using ultrasonic signals not RF throughout the disclosure, and as such, because there is not clear teaching of using RF signals, there is not a teaching of the combination. This argument is disagreed with because one of ordinary skill in the art would recognize the meaning of "R.F. transmitter" referred to by Murry, and as such, the reference does teach that RF signals can be used. That the reference also teaches using ultrasonic signals in the described embodiments does not obviate this teaching. Further, it is well known in the art that RF, ultrasonic and infrared are recognized equivalent ways of sending signals, see the cited



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references to Garcia et al (5355804) and Berger et al (5408284). Therefore, it is held that Murry does properly teach using remote signal control and properly suggests using RF signals.

Applicant argues, with respect to claims 2 and 3, that not every limitation is shown because a first RF signal having a first identifier value associated with a first device is not shown and a second RF signal having a second identifier value associated with a second device is not shown. It is further argued that while Murry shows using ultrasonic signals of different frequencies that correspond to different devices, the reference does not show using identifier values. The argument is disagreed with because Beier (681) teaches identifying devices using different electric signals and Murry teaches identifying devices as stated. To call these signals identifier values is merely terminology, and as such, is properly not given patentable weight. The use of RF signals has been shown to be obvious as discussed above.

Applicant's remarks with respect to claims 3-5 are held to be adequately responded to above.

Applicant further argues, with respect to claims 29 and 30, that not every limitation is shown because there is no showing of a third RF signal to control time of operation. This argument is held to be moot in view of the newly applied reference to Nash above.

Applicant argues, with respect to claims 8-11, that there is no motivation for combining Jones because Jones includes a foot control 20 that uses an electric switch 70 which is either open or closed, and as such, if combined with Beier (681) would destroy the variable control of that reference. This argument is not agreed with because Jones has been used to show that pneumatic valve switches are known in the art for controls, and as such, properly suggests to the skilled artisan an alternative type of switch that may be used. It is not inherently necessary to

combine all of the functionality of Jones into Beier (681) as assumed by applicant, and as such, the combination would not destroy Beier (681). Further, the combination does properly show every element in that it does suggest to one of ordinary skill in the art the use of a pneumatic switch.

Applicant further argues, with respect to claims 9-11, that not every limitation is shown because no pressure sensor coupled to a microprocessor is shown. The above rejection has been modified to state that Murry teaches using a pressure sensor 58, and as such, this argument is held to be moot.

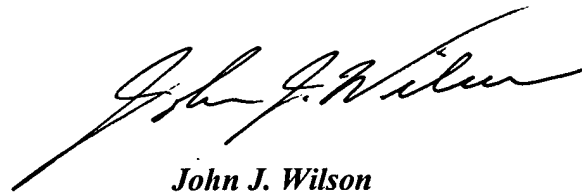
Applicant argues, with respect to claims 18 and 27, that there is not proper motivation for the combination because Murry is not combinable with Beier (681). This argument has been addressed above. Applicant further argues that not every limitation is shown because not video capture board with an activation system activated by an RF signal is shown, that no video image in memory in response to an RF signal is shown, and that no video capture card is shown. This argument is disagreed with because Fornoff does teach capturing video and stills. It is well known in the art to use a video board for processing video and a video capture card for capturing video and capturing stills from video, and as such, the teaching of Fornoff properly suggests the combination and the claimed elements to one of ordinary skill in the art. With respect to the use of RF signals, that has been addressed above with the remarks related to the combination with Murry.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



***John J. Wilson***  
***Primary Examiner***  
**Art Unit 3732**

jjw  
March 3, 2006